

REMARKS/ARGUMENTS

Favorable reconsideration of this application as currently amended and in light of the following discussion is respectfully requested.

Claims 1, 2, 5-11, 13-18, and 20-23 are currently pending. The present Amendment amends Claims 1, 5, 9, 10, 13, 17, 18, and 20-23 and cancels Claims 3, 4, 12, 19, and 24-30 without prejudice or disclaimer. The changes to the claims are supported by the originally filed application. No new matter has been added.

In the outstanding Office Action, the information disclosure statement filed on July 12, 2002, was noted as non-compliant; Claims 24-30 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter; Claims 1, 3-9, 12-17, 19-24, and 26-30 were rejected under 35 U.S.C. § 102(e) as being anticipated by Ishii et al. (U.S. Patent No. 6,546,188, herein "Ishii"); Claim 10 was rejected under 35 U.S.C. § 102(e) as being anticipated by Newman et al. (U.S. Patent No. 6,154,600, herein "Newman"); and Claims 2, 11, 18, and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishii in view of Nadas et al. (U.S. Patent No. 6,621,504, herein "Nadas").

In response to the indication that the information disclosure statement of July 7, 2002, fails to comply with 37 C.F.R. § 1.98(a)(1), Applicant respectfully submits that a revised List of Related Cases, including a column for the Examiner's initials, and a PTO 1449 form herewith. Further, Applicant respectfully requests formal acknowledgment of the consideration of the references cited in the information disclosure statement of April 12, 2002.

Claims 24-30 are cancelled without prejudice or disclaimer thus rendering the rejection moot. Nevertheless, Applicant's traverse the Office Action's assertion that Claims 24-30 are directed to non-statutory subject matter because the claims refer to a storage medium. A storage medium is an article of manufacture, and is thus, statutory in subject

matter. Furthermore, the specification at paragraph 170 provides a number of examples of program storage mediums.

In response to the rejection of Claims 1, 3-9, 12-17, 19-24, and 26-30 under 35 U.S.C. § 102(e), Applicant respectfully requests reconsideration of the rejection and traverses the rejection for the reasons set forth below.

The Office Action asserts at page 4 that Ishii teaches “the arrangement of said effect specifying information includes a first arrangement for specifying short-term effects which can be applied for specified time, and a second arrangement for specifying continuous effects which can be continuously applied,” as originally recited in Claim 4 and supports this assertion with column 22, lines 15-67, of Ishii. Applicant respectfully disagrees and submits that Ishii explains in the cited passage that “the time-line display area 40 has a time-scale display portion 40a, GDI/DSK track 40b, *effects track 40c*, video track 40d.”¹ Ishii further states that “[a] mark 40ca is displayed at a position on *the* effects track 40c to which an effect has been set.”² It follows that since the teachings of Ishii asserted to meet the features of Claim 4 pertain to effects that are on a single track, the teachings of the cited passage are not consistent with the arrangements of Claim 4 that depend from Claim 3 (both of which are now incorporated into Claim 1) which recites “plural lines” of effects. Further, Applicant notes that there is no mention or suggestion of any “continuous effects which can be continuously applied” in Ishii. Therefore, there is no teaching or suggestion of a pair of the claimed arrangements in Ishii and thus even less of “a first arrangement for specifying short-term effects which can be applied for specified time” in combination with “a second arrangement for specifying continuous effects which can be continuously applied,” which help users choose effects easily and quickly.

¹ Ishii, column 22, lines 27-29. Emphasis added.

² Ishii, column 22, lines 54-55. Emphasis added.

In light of the above discussion, independent Claim 1 is amended to incorporate the features of Claims 3 and 4. Similarly, independent Claims 9 and 10 are amended to incorporate Claim 12 and independent Claim 17 is amended to incorporate Claim 19. Further, Claims 17, 18, and 20-23 are amended solely with respect to form to recite a computer program product rather than a program, and Claims 24-30 which recited a medium for recording the claimed program are cancelled.

Therefore, Ishii fails to teach or suggest every feature recited in Applicant's amended independent Claims 1, 9, 10, and 17, so that Claims 1, 2, 5-11, 13-18, and 20-23 are patentably distinct over the Ishii. Accordingly, Applicant respectfully traverses, and requests reconsideration of, the rejection based on the Ishii patent.³

In response to the rejection of Claim 10 under 35 U.S.C. § 102(e), independent Claim 10 is amended to incorporate the features of Claim 12.

Applicant respectfully submits that Newman, which is directed to a non-linear editing system for home audio and video application including a compression/decompression engine, does not teach or suggest that "said arrangement display step is to display the arrangement of said effect specifying information in plural lines; and the arrangement of said effect specifying information includes a first arrangement for specifying short-term effects which can be applied for specified time, and a second arrangement for specifying continuous effects which can be continuously applied," as recited in amended independent Claim 10.

Therefore, Newman fails to teach or suggest every feature recited in Applicant's amended independent Claims 10, so that Claim 10 is patentably distinct over Newman.

³ See M.P.E.P. 2131: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," (Citations omitted) (emphasis added). See also M.P.E.P. 2143.03: "All words in a claim must be considered in judging the patentability of that claim against the prior art."

Accordingly, Applicant respectfully traverses, and requests reconsideration of, the rejection based on the Newman patent.

In response to the rejection of Claims 2, 11, 18, and 25 under 35 U.S.C. § 103(a), Applicant respectfully requests reconsideration of the rejection and traverses the rejection for the reasons set forth below.

Applicant respectfully submits that Nadas, which is directed to a property editor in a graphics image system, does not teach or suggest that "said effect specifying information arranging means displays the arrangement of said effect specifying information in plural lines; and the arrangement of said effect specifying information includes a first arrangement for specifying short-term effects which can be applied for specified time, and a second arrangement for specifying continuous effects which can be continuously applied," as recited in amended independent Claim 1 and similarly recited in amended independent Claims 9 and 17, which features are not taught by Ishii.

Therefore, even if the combination of the Ishii and Nadas patents is assumed to be proper, the combination fails to teach every element of the claimed invention. Accordingly, Applicant respectfully traverses, and requests reconsideration of, this rejection based on these patents.⁴

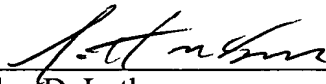
Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 1, 2, 5-11, 13-18, and 20-23 is earnestly solicited.

⁴ See MPEP 2142 stating, as one of the three "basic criteria [that] must be met" in order to establish a *prima facie* case of obviousness, that "the prior art reference (or references when combined) must teach or suggest all the claim limitations," (emphasis added). See also MPEP 2143.03: "All words in a claim must be considered in judging the patentability of that claim against the prior art."

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicant's undersigned representative at the below listed telephone number.

Respectfully submitted,

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